1742

[10191/1438]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	:	KNOLL et al.
Serial No.	:	09/555,777
Filed	:	November 1, 2000
For	:	METHOD FOR PRODUCING COMPOSITE MATERIALS AND EXAMPLES OF SUCH COMPOSITE MATERIALS
Examiner	:	D. Jenkins
Art Unit	:	1742

Assistant Commissioner
for Patents
Washington, D.C. 20231

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on
Dated: 3/6/02
Reg. 41,172
Signature: [signature]
DERVIS MAGISTRE
KENYON & KENYON

ELECTION WITH TRAVERSE TRANSMITTAL

SIR:

Please find an Election With Traverse transmitted herewith for filing in the above-identified patent application. Applicants respectfully request a one-month extension of time in which to respond to the Office Action dated January 16, 2002, for which a response period expiring on February 16, 2002 was set. The extended period expires on March 16, 2002.

Please charge the **$110.00** extension fee and any additional fees required to Deposit Account No. 11-0600. A duplicate copy of this Transmittal is enclosed.

Respectfully submitted,

COPY OF PAPERS ORIGINALLY FILED

By [signature] (Reg. No. 41,172)

Dated: 3/6/02

By: [signature]
Richard L. Mayer
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#9
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Assistant Commissioner
for Patents
Washington, D.C. 20231

ELECTION WITH TRAVERSE

SIR:

In response to the Restriction Requirement dated January 16, 2002, Applicants elect, with traverse, the claims in Group II, namely, claims 47-54. Applicants traverse the Restriction Requirement for the reasons set forth in the following paragraphs.

REMARKS

In the Restriction Requirement, the Examiner divided the claims into two groups. According to the Examiner, one group is directed to a method for forming a composite, and the other is directed to a composite material. As a justification for this Restriction Requirement, the Examiner reasons that these groups of claims are distinct from each other because "the product as claimed can be made by another and materially different process" such as by "a non-reactive process." Restriction Requirement at page 2.

Applicants traverse this restriction requirement because the Examiner has relied on the wrong standard, distinctness, instead of on the one required for § 371 national stage applications, namely, unity of invention. In particular, in basing the restriction determination on the alleged distinctness between the two groups of claims, the Examiner has

ignored the strictures governing unity of invention determinations set forth in Rules 475 and 499. According to § 1893.03(d) of the MPEP, "[e]xaminers are reminded that unity of invention (not restriction) practice is applicable...in national stage (filed under 35 U.S.C. 371) applications." Rule 475(b) reads, in pertinent part, as follows:

> An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:
>
> (1) A product and a process specially adapted for the manufacture of said product....

(Emphasis added). According to the cited portion of Rule 475, if the claims are directed only to a "product" and "a process specially adapted for the manufacture of said product", the Patent Office must, not may, treat the application as having unity invention. The Patent Office has no discretion in this matter, since the Rule specifically states that if the national stage application satisfies one of the conditions in Rule 475(b), the "national stage application ... will be considered to have unity of invention." Thus, under this rule, the determination by the Examiner of whether the inventions are distinct is not relevant to the claims of this national stage application. The Rule directs the focus of the inquiry not on whether the product may be manufactured according to another materially different process, as the Examiner asserts, but simply on whether the claims in this application are directed only to a product and a process specially adapted to produce that product.

In this application, Applicants submit that this condition is met. According to the MPEP,

> a process is 'specially adapted' for the manufacture of a product if the claimed process inherently produces the claimed product with the technical relationship being present between the claimed process and the claimed product. The expression 'specially adapted' does not imply that the product could not also be manufactured by a different process.

MPEP at § 1893.03(d). Both claim 28 and claim 47 recite a metal silicide. Applicants submit that at least this common limitation is the basis for asserting that the process is 'specially adapted' for the manufacture of the claimed composite material because this common limitation establishes a technical relationship between the groups of claims. Therefore, because the claims of the present application fall within Rule 475(b)(1), Applicants submit that the above-referenced application has unity of invention, and therefore, respectfully request withdrawal of the Restriction Requirement so that all of the presently pending claims may be examined.

Respectfully submitted,

By: [illegible] (Reg No. 41,172)

Dated: 3/6/02

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